

Remarks

This application has been reviewed in light of the first Office Action. Claims 1-21 are pending. Claims 16-19 are allowed, claims 4 and 12 are objected to, and the remaining claims are rejected.. In response, claims 1 and 5 are amended; claim 3 is canceled, without prejudice; and the following remarks are submitted. Reconsideration of this application, as amended, is requested.

In reviewing the attachments to the Office Action, the undersigned noticed that there was no initialed Information Disclosure Citation corresponding to Applicant's Second Information Disclosure Statement. The undersigned contacted the Examiner, who could not find the Second Information Disclosure Statement in the file. Applicant attaches hereto a copy of the Second Information Disclosure Statement and the postcard indicating receipt in the PTO. Applicant asks that the Examiner consider these references and make them of record. All are US Patents and should be readily available. If not, Applicant can submit an additional set of the references.

A main embodiment of the present invention is an apparatus for processing an elastomeric article that is either on a form or worn by a person. In the latter case, the person wearing the gloves places his/her hands through openings in the enclosure and to the article support location. The gloves are then cleaned of particulate matter by the ionized gaseous cleaning agent. The Caputo reference cannot anticipate or make obvious such an approach, because it requires the use of a vacuum. The use of a vacuum is incompatible with openings through which the gloved hands are placed to gain access to the interior of the enclosure while the cleaning process is underway.

Sec. 102 Rejection

Claims 1, 7, and 8 are rejected under 35 USC 102 as anticipated by Caputo US

Patent 5,288,460. Applicant traverses this ground of rejection.

The following principle of law applies to sec. 102 rejections. MPEP 2131 provides: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim. The elements must be arranged as required by the claim..." [citations omitted] This is in accord with the decisions of the courts. Anticipation under section 102 requires 'the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim.' Carella v. Starlight Archery, 231 USPQ 644, 646 (Fed. Cir., 1986), quoting Panduit Corporation v. Dennison Manufacturing Corp., 227 USPQ 337, 350 (Fed. Cir., 1985)

Thus, identifying a single element of the claim which is not disclosed in the reference is sufficient to overcome a Sec. 102 rejection.

Caputo teaches a plasma sterilizing apparatus and process. The process is conducted in a medium vacuum of 0.1-10 Torr (Abstract; col. 3, line 4), or possibly as high as 100 Torr (claim 10). 100 Torr is about 0.13 atmosphere.

Claim 1 as amended recites in part:

"an access port with a non-hermetic gland seal therein sized so that a person wearing the elastomeric article may insert a hand and an arm through the gland to position the elastomeric article at an article support location"

As discussed at page 11, lines 6-19 of the Specification, in this embodiment now recited in claim 1, the user wears the article and thrusts the hands and arms into the chamber through the gland. This approach is possible because the pressure differential between the environment outside of the enclosure and the interior of the enclosure is small.

As far as Applicant can tell, Caputo discloses no elastomeric article as recited in the claims.

Caputo discloses no gland seal, because in Caputo the plasma process is conducted in a vacuum of no more than about 0.13 atmosphere. It would not be possible in Caputo for a person to thrust the covered hands into the interior of the chamber through a gland seal, because air would rush into the chamber to destroy the vacuum. Additionally, the elastomeric article would balloon and break under the applied vacuum.

Claim 1 further recites in part:

"the ionized gaseous cleaning agent being operable to dislodge a particulate contaminant from the elastomeric article and entrain the particulate contaminant in the gaseous flow as it passes by the elastomeric article"

Caputo has no disclosure of dislodging particulate contaminant from an article.

Claim 7 recites a "weakly ionized plasma source", and Caputo has no such disclosure. Claim 8 recites a number of different cleaning materials. Caputo has no disclosure of using such cleaning materials in his process. Instead, the discussion of hydrogen peroxide in Caputo is a discussion of unsuitable prior art materials (col. 2, lines 5-20) that are contrasted to the types of atmospheres used in Caputo's own process (col. 3, lines 11-20). Caputo's disclosure is directly contrary to the approach recited in claim 8.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

#### General Discussion of Law Applicable to Sec. 103 Rejections

The following principle of law applies to all sec. 103 rejections responded to herein. MPEP 2143.03 provides "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F2d 981, 180 USPQ 580 (CCPA 1974)." That is, to have any expectation

of rejecting the claims over a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not taught in any of the applied prior art, the rejection cannot stand. In this case, the applied prior art references clearly do not arguably teach some limitations of the claims.

Further, MPEP 2143.01 provides that, in constructing a sec. 103 rejection, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. MPEP 2143.02 requires that, in combining the teachings of two references, there must be a reasonable expectation of success in the combination. Both of these mandates would be violated in the proposed rejections, all of which are based on Caputo. Caputo requires a medium vacuum.

Further, the rejection may not properly be based on a reference which teaches away from the present invention as recited in the claims.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. In re Sponnoble, 160 USPQ 237 244 (CCPA 1969)...As "a useful general rule,"..."a reference that 'teaches away' can not create a prima facie case of obviousness." In re Gurley, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)"

Caputo teaches away from the inventions as recited in the claims, because it requires a moderate vacuum that is incompatible with the presently claimed approach. The present rejection is a sec. 103 combination rejection. It is well established that a proper sec. 103 combination rejection requires more than just finding in the references the elements recited in the claim (but which was not done here). To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2143 and 2143.01. See also, for example, In re Fine, 5 USPQ2d 1596, 1598 (at

headnote 1) (Fed.Cir. 1988), In re Laskowski, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311-313 (Fed. Cir., 1983), and Ex parte Levengood, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993); Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351 (Board of Appeals 1984). As stated in In re Fine at 5 USPQ2d 1598:

"The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

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"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

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"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd.Pat.App.& Inter. 1993)."

Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and selecting the helpful portions from each reference while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. If the rejection is maintained, Applicant asks that the Examiner set forth the objective basis found in the references themselves for combining the teachings of the references.

All of these principles of law apply to the following Sec. 103 rejections, and the above discussion is incorporated into the response regarding each of these sec. 103 rejections.

#### Sec. 103 Rejections

Claim 3 is rejected under 35 USC 103 over Caputo in view of Guzman. Applicant traverses this ground of rejection.

Claim 3 depends from claim 1. Caputo does not teach the limitations of claim